



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/163,771

09/30/98

LESLIE

R

IBC-SOFFIT-1

PM82/0930

ROBERT J JACOBSON  
790 CLEVELAND AVENUE SOUTH  
SUITE 202  
ST PAUL MN 55116-1958

EXAMINER

WILKENS, K

ART UNIT

PAPER NUMBER

3635

DATE MAILED:

09/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/163,771

Applicant(s)  
Robert H. Leslie et al.

Examiner  
Kevin Wilkens

Group Art Unit  
3635



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 29-45 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 29-45 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Sep 30, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### **GENERAL COMMENTS REGARDING REQUEST FOR CORRECTED FILING RECEIPT**

The request for corrected filing receipt (filed 10-28-98) is noted; however, the requested corrections have not been made as of the time of this Action. The Office apologizes for the delay in processing this request. The request will be handled expeditiously after the mailing date of this Action; should Applicant not receive a corrected filing receipt shortly after receipt of this Action, he is invited to call the undersigned to confirm the status of the request.

### **OBJECTIONS TO THE DRAWINGS**

The drawings are objected to because figs. 5, 24, 25, 26, 50, and 52 do not comply with 37 C.F.R. 1.84(h)(1) regarding the use of brackets on exploded views appearing on drawing sheets with other figures. Correction is required. ✓

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the oriented strand board (i.e. claims 32 & 34), the compressed wood strands in right-angled layers and waterproof adhesive (i.e. claims 33 and 44), the dimensional lumber (i.e. claim 34), and the soffit extending between plural rafters (i.e. claims 35 and 41) must all be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### **OBJECTIONS TO THE SPECIFICATION**

The disclosure is objected to because of the following informalities: in the related application information (i.e. the first paragraph of page 1), Applicant should update the status of the related application as it has since issued as a U.S. Patent. Appropriate correction is required.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

Claims 29-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 29 is indefinite since the scope of the invention is unclear; the preamble recites the roof overhang and the wall in a functional manner only (i.e. "for a shelter having a roof overhang and a wall structure"), yet the body of the claim recites a positive connection between the soffit, roof overhang, and wall (i.e. "flanges engaged to the wall structure" and "flange engaged to a portion of the roof overhang"). Therefore, it is unclear if the claim is directed to the combination of the soffit **and** roof overhang/wall structure, or to the soffit **only**. Additionally, the phrase "following such travel" should be "following said travel". Claim 36 is confusing due to the phrase "the rafter comprises an I-beam"; since Applicant has previously recited a plurality of rafters, a suggested correction is "the rafters comprise I-beams". Claims 41 and 44 are indefinite due to the phrase "following such travel"; a suggested correction is "following said travel".

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 29-31, 35, and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Anthony. As the claims are best understood, Anthony discloses the claimed soffit/shelter/roof overhang/wall structure as shown in figs. 1, 1A, & 2. An "I-joist" having an elongate web (22) is secured to a pair of flanges (20, 26) on the elongate edges thereof. One flange (26) is secured to the wall structure (32), the other flange (26) is secured to the roof overhang (34). The soffit extends along a portion of the perimeter of the shelter as shown

in fig. 1. The soffit extends at generally a right angle to the wall, and the I-joist is formed of organic matter (i.e. wooden components). A plurality of rafters (40) form a part of the roof of the shelter, with the flange (26) being secured to, and extending between, the rafters (40) via element (34). A portion of the web (22) is cut away (as at 27) for ventilation purposes.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anthony. As discussed above, Anthony discloses the claimed system; however, there is no specific mention that the rafters are I-beams. It would have been obvious to one of ordinary skill in the art to use I-beams for the Anthony rafters, based upon known construction/roofing techniques at the time of the instant invention. The resultant system remains functionally equivalent, since the I-joist soffit is still secured to the rest of the shelter's components as intended, regardless of what type of rafter is used for the roof.

Claims 29, 30, 35, 36, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinckney, Jr. As best shown in fig. 1, Pinckney discloses the claimed soffit/roof overhang/wall structure, comprised of an "I-joist" having an elongated web (10) between flanges (18, and 12/50). The soffit is secured to the wall (14) via flanges (12/50), and to the roof overhang (20) via flange (18). The soffit is generally at a right angle to the wall structure. Flange (18) is secured to and extends between a plurality of rafters as claimed. A portion of the soffit's web is cut away (as at 30) for ventilation purposes. However, there is no specific mention that the I-joist has a **pair** of flanges (i.e. that members 12/50 are one-piece in

design), nor is there specific mention that the rafters are I-beams. It would have been obvious to one of ordinary skill in the art to form the flange (12/50) as a one-piece member, thereby giving the Pinckney I-joist a pair of flanges, so that the assembly of the entire eave is easier. Additionally, the use of I-beams for Pinckney's rafters would have been obvious to one of ordinary skill in the art, based upon known construction/roofing techniques in the art at the time of the instant invention. The resultant system remains functionally equivalent, since the I-joist soffit is still secured to the rest of the shelter's components as intended, regardless of what type of rafter is used for the roof.

Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anthony in view of Lambuth. As discussed previously, Anthony discloses the claimed invention; however, there is no specific mention that the web of the I-joist is comprised of Oriented Strand Board (OSB), which was known in the art to be comprised of compressed wood strands in layers at various angles to each other (including right angles), with the layers being bonded together. Lambuth discloses an I-beam of composite organic construction. The web (12) is comprised of OSB, in that it has layers (18, 20, and 22) of wood strands at generally right angles to each other (note grain directions  $d_o$  and  $d_i$  in fig. 1), with the layers being bonded together. The flanges (17, 16) are of dimensional lumber. It would have been obvious to one of ordinary skill in the art to use a composite I-beam/joist having an OSB-configured web and dimensional lumber flanges (as taught by Lambuth) for the Anthony system, since it was common in the construction art at the time of the invention to substitute different types of wood for each other. Anthony discloses that the web (22) and flange (20) are of pine, and that the flange (26) is plywood. Since Lambuth discloses a known I-beam/joist configuration, which is also of organic matter, one of ordinary skill in the art would have found it obvious to use Lambuth's materials for Anthony's I-joist. A functionally equivalent system results, in that both I-joists are made of organic materials and connect to the rest of the construction components the same regardless of what type of wood is used. The specific use of waterproof adhesive in the Anthony/Lambuth I-joist would have been obvious to one of ordinary skill in the art, since the soffit is exposed to the elements when installed.

### **CITATION OF POTENTIALLY ALLOWABLE CLAIMS**

Claims 41-45 would appear to be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action. The allowable subject matter is directed to the combination as claimed, wherein a fascia is secured to one of the flanges of the I-joist soffit.

Claims 37, 38, and 40 would appear to be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The allowable subject matter is directed to the fascia secured to one of the flanges of the I-joist (i.e. claim 37), the cutaway in the flange (i.e. claim 38), and the cutaway in the flange and web (i.e. claim 40).


### **CITATION OF PERTINENT ART**

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

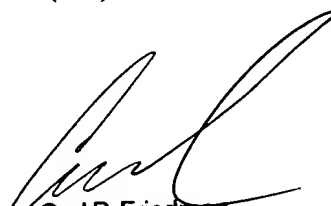
### **INQUIRY CONTACTS**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kevin Wilkens whose telephone number is (703) 308-2168.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



Kevin Wilkens  
September 23, 1999



Carl D. Friedman  
Supervisory Patent Examiner  
Group 3600